

Application No. 10/825,531

Reply to Office Action

*REMARKS/ARGUMENTS**Specification Amendment*

The specification has been amended to recite the correct parentage and to provide the current status of the parent application. No new matter has been added by way of the specification amendment.

The Requirement for Restriction and Election of Species

The Examiner has set forth a restriction requirement between the following groups:

- (i) Group I (claims 1-15) directed to compounds, and
- (ii) Group II (claims 16-18) directed to therapeutic methods.

Additionally, the Examiner requires that Applicants elect a single claimed species from among the following identities of the variable Z:

- (1) H or an alkyl-type protecting group,
- (2) carbonyl- or thiocarbonyl-containing group, and
- (3) thio group

According to the Examiner, where product claims are elected and found to be allowable, Applicants can request the rejoinder and consideration of the method claims to the extent the method claims are dependent on the allowed product claims or otherwise recite all of the limitations of the allowed product claims.

Applicants' Election

Applicants elect, with traverse, the claims of Group I (i.e., claims 1-15) for further prosecution. With respect to the species election requirement, Applicants elect, with traverse, Species 1 (Z = H or an alkyl-type protecting group), of which the compound of Example 10 (specification page 61) is exemplary, for examination. All of the claims of elected Group I (i.e., claims 1-15) encompass the selected species.

Application No. 10/825,531

Reply to Office Action

Discussion of the Restriction Requirement

There are two criteria for a proper requirement for restriction between patentably distinct inventions: (i) the inventions must be independent or distinct as claimed, and (ii) there must be a serious burden on the Examiner if restriction is not required. M.P.E.P. § 803. Consequently, as set forth in M.P.E.P. § 803: "If the search and examination of all the claims in an entire application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to distinct or independent inventions."

As discussed at M.P.E.P. § 806.05(h), a mere allegation, without support, is insufficient to support a restriction requirement. Rather, "[t]he burden is on the examiner to provide an example ... [and] the burden is on the examiner to support a viable alternative use or withdraw the requirement." See also Examiner Notes 2(a) and 2(b) at M.P.E.P. § 806.05(h).

In addition and specifically with respect to the species election, even if related species are shown to be distinct under the criteria of M.P.E.P. § 806.05 (c)-(i), "the examiner, in order to establish reasons for insisting upon restriction, must explain why there would be a serious burden on the examiner if restriction is not required ... [and] must show by appropriate explanation one of the following: (1) separate classification thereof ... (2) a separate status in the art when they are classifiable together ... (3) a different field of search." M.P.E.P. § 808.02. Moreover, "[w]here ... the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." M.P.E.P. § 808.02.

Applicants respectfully submit that there would not be a serious burden on the Examiner if the alleged groups and species of the pending claims were searched together. The nature of the claims, and the subject matter encompassed by the claims, is such that there would be no undue burden on the Examiner to consider all the claims at the same time. Indeed, the claims of Group II (i.e., claims 16-18) all recite the compound of, and are dependent upon, claim 1 of elected Group I. Moreover, the compounds of elected Species 1 differ from the compounds of Species 2 and 3 only by the mercapto-protecting group on the compounds. Additionally, the Examiner has failed to show by appropriate explanation any

Application No. 10/825,531

Reply to Office Action


separate classification, separate status in the art when classifiable together, or a different field of search for Species 1, 2, and 3. Applicants are not asserting that the pending claims necessarily stand and fall together. Instead, Applicants contend that the relationship of the pending claims, and subject matter encompassed by the pending claims, renders the restriction requirement improper.

Accordingly, Applicants respectfully request that the Examiner withdraw the group and species restriction requirements issued against the pending claims. In any event, consistent with an election of species requirement, other species within the elected "genus" (i.e., claims 1-15 of Group I) should be considered by the Examiner upon an indication of allowable subject matter with respect to the elected species. Moreover, if the elected claims are found to be allowable, Applicants reserve the right to seek the rejoinder of the nonelected claims that are dependent on the allowed claims.

Conclusion

If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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